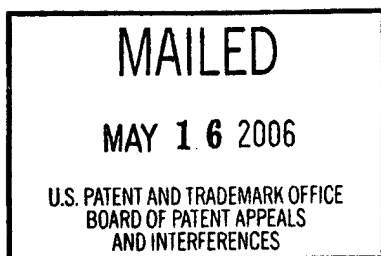


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte SHLOMI HARIF

Appeal No. 2006-0598
Application No. 09/752,072

ON BRIEF ¹

Before FRANKFORT, LEVY, and NAPPI, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-30, which are all of the claims pending in this application.

We REVERSE.

¹ The Oral Hearing scheduled for April 4, 2006 was waived by appellant in a communication, received via facsimile, on March 10, 2006.

BACKGROUND

The appellant's invention relates to a system, method and program for bidding for best solution process execution in a heterogeneous network (specification, page 1).

Claim 1 is representative of the invention, and is reproduced as follows:

1. A system for bidding for a process execution over a heterogeneous network, said system comprising a network server adapted to receive a payload over the heterogeneous network from a network client, wherein the payload comprises specifications for a process execution associated with a task, wherein the server is further adapted to simulate the process execution by estimating computing resources required to carry out the process execution associated with the task, and provide a bid solicitation for the process execution from a network host.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Semret et al. (Semret) US 2003/0101124 May 29, 2003²

Claims 1-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Semret.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

²This published application claims priority under 35 U.S.C. § 119(e) to U.S. Provisional Application No. 60/203,849, filed May 12, 2000.

rejection, we make reference to the answer (mailed July 28, 2005) for the examiner's complete reasoning in support of the rejection, and to the brief (filed April 11, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we make the determinations which follow.

We begin with claim 1. To anticipate a claim, a prior art reference must disclose every limitation of the claimed

invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The examiner's position (answer, page 3) is that:

As per claim 1, Semret discloses a system for bidding for a process execution over a heterogeneous network, said system comprising a network server adapted to receive a payload over the heterogeneous network from a network client, wherein the payload comprises specifications for a process execution associated with a task, wherein the server is further adapted to simulate the process execution, and provide a bid solicitation for the process execution by estimating computing resources required to carry out the process execution associated with the task, and provide a bid solicitation for the process execution from a network host (see figure 1 and associated text; ¶10-13, 34-35).

Appellant's position (brief, page 3) is that Semret fails to teach or suggest a system with a network server configured to provide a bid solicitation from a network host for a process execution requested by a network client.

Appellant further asserts (brief, page 4) that Semret fails to teach or suggest a network server that simulates a process execution requested by a network client.

It is additionally asserted (id.) that Semret fails to teach or suggest estimating computer resources required to carry out the process execution.

At the outset, we note that Manual of Patent Examining Procedure (Eighth Ed., Rev. 2 May 2004) § 1208, which was in

effect at the time the examiner's answer was written, requires that a rejection under 35 U.S.C. § 102 point out where all of the specific limitations recited in the rejected claims are found in the prior art found in the rejection. This MPEP section additionally requires that:

(e) For each rejection under 35 U.S.C. 102 . . . where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art as appropriate.³

From our review of the cited MPEP section, we find that the examiner's reprinting of the language of claim 1, almost verbatim, followed by a broad reference to figure 1 and paragraphs 10-13, 34 and 35, does not comply with the requirements of the MPEP for the content of an examiner's answer. In particular, in view of appellant's questioning (brief, pages 3-5) as to how limitations in the claims correspond to features of the prior art, the failure to provide appellant with a side-by-side comparison of the language of a claim with reference to the

³ Similar language currently appears in MPEP § 1207.02.

specific page, line number, drawing reference number, etc. fails to provide a prima facie case of anticipation of claim 1.

In addition, from our review of the entire published Semret application, we agree with appellant, for the reasons found on pages 4 and 5 of the brief, that Semret's disclosure fails to anticipate claim 1. Semret is directed to a system and method for allowing buyers and sellers to bid for resources, and controlling the resources in accordance with the bids (para. 3). Semret discloses that recently, the need for a dynamic bandwidth commodity market has been recognized (para. 7), and that "the emerging telecommunications market call for new mechanisms for real-time trading of network resources, such as bandwidth" (para. 9). The invention provides a platform for resource allocation in real-time, where one or more resource agents interact with software player agents to reach an agreement on price and quantity allocations for each buyer of the resource (para. 10). Seller agents contain their own strategy and valuation rules, which allow them to decide how much of a resource to offer and how to set a minimum price for the resource (id.). In general, the invention promotes the sharing of limited resources such as bandwidth, buffer space, etc., (para. 12). A typical system

includes buyer and seller agents 102 as well as a resource agent 104, an accounting agent 106, a network control and management agent 108 and a resource 110 (para. 32). A buyer places a bid with the resource agent, which ultimately decides which of the player agents is awarded a portion of each resource for a predetermined amount of time (para. 33). The allocation command, shown in figure 1, will include an identification of the winning buyer or buyers and an identification of the amount of resource allocated (para. 34). Network control and management agent 108 controls resource 110 to implement the allocation command received from resource agent 104. Agent 108 commits the allocated resource to a player after the resource agent has closed the bidding (para. 35). Once the winning buyers are determined, resource agent 104 alerts accounting agent 106, which keeps track of the winning buyers (para. 37).

As shown in figure 4, when the bidding ends, seller agent 102 will receive, from resource agent 104 a notification 404 of the winning bidder or bidders (para. 45). Figure 5 shows how resources are allocated after bidding is closed (para. 73). Figure 9(b) shows how winning buyer ISP 952 is given a resource, such as bandwidth (para. 88).

From the disclosure of Semret, we find that the reference does teach the network server to be configured to provide a bid solicitation from a network host for a process execution requested by a network client. In Semret, when a seller player agent 102 decides to accept bids for a specified amount of bandwidth, resource agent 104 solicits bids from different buyer player agents. To the extent that the different buyers can be considered network hosts, this limitation of claim 1 is met. However, because resource agent 104 receives the bids and determines the winning buyer or buyers, Semret does not teach a network server that simulates a process execution. Similarly, Semret does not teach simulating the process execution by estimating computing resources required to carry out the execution process.

We are not persuaded by the examiner's assertion (answer, pages 7 and 8) that Semret's pricing simulations (pages 57-62) of the article that is attached to the patent application is a teaching of simulating the process execution. The fact that the article discloses pricing simulations using Monte-Carlo simulation, is not a disclosure of simulating a process execution

by estimating computing resources required to carry out the process execution associated with the task.

In addition, the fact that resource agent 104 of Semret conducts bidding and allocates resources does not mean that the resource agent 104 simulates the process execution by estimating computing resources required to carry out the task.

Nor are we persuaded by the examiner's assertion (answer, page 8) that the examples of figures 15(j), 15(k) and 15(l) of Semret teach computing resources to carry out process execution. From our review of figures 15(j), 15(k) and 15(l) we find that these figures are directed to bidding strategies for buyers, and not to simulating process execution by estimating resources necessary to carry out the process execution associated with the task, as required by claim 1.

From all of the above, we find that the examiner has failed to establish a prima facie case of anticipation of claim 1. The rejection of claim 1 under 35 U.S.C. § 102(e) is reversed. As independent claims 14 and 29 contain the same or similar language, the rejection of claim 14 and 29 is reversed. As the remaining claims depend from claims 1, 14 or 29, the rejection of claims 2-13, 15-28 and 30 under 35 U.S.C. § 102(e) is reversed.

To summarize, the decision of the examiner to reject claims 1-30 under 35 U.S.C. § 102 is reversed.

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

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ROBERT E. NAPPI
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